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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/065,308	04/23/1998	JOSEPH D. MARESH		7296

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EXAMINER

CROW, STEPHEN R

ART UNIT PAPER NUMBER

3764

DATE MAILED: 02/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/065,308

Applicant(s)

MARESH, JOSEPH D.

Examiner

Steve R Crow

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3764

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 10-22 are rejected under the judicially created doctrine of double patenting over the claims of the U. S. Patents listed below. since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

All of the patents disclose stepping machines having a frame, left and right cranks rotatably mounted on the frame, left and right guides, and left and right foot supports, wherein an ellipse is produced wherein the vertical elliptical axis is greater than the horizontal elliptical axis.

Art Unit: 3764

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. Claims 10-22 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5997445. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims appear to be met by the disclosure of the patent. Note figure 6.

4. Claims 10-22 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 5707321. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims appear to be met by the disclosure of the patent.

5. Claims 10-22 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5735774.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims appear to be met by the disclosure of the patent. Note figure 5.

Art Unit: 3764

6. Claims 10-22 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5924963. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims appear to be met by the disclosure of the patent. Note figures 1-2.

7. Claims 10-22 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6035923. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims appear to be met by the disclosure of the patent. Note figures 5,8,9.

8. Claims 10-22 are rejected under the judicially created doctrine of double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5897463. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims appear to be met by the disclosure of the patent.

Response to Arguments

8. Applicant's arguments filed 12-10-02 have been fully considered but they are not persuasive.

The election requirement was made because of the burdensome search required.

The examiner has withdrawn the parent patents from Double Patenting which fail to clearly show an ellipse produced wherein the vertical elliptical axis is greater than the horizontal elliptical axis.

Art Unit: 3764


Furhtermore, a Double Patenting sing parent Patent 5897463 has been added for the record.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Crow whose telephone number is (703) 308-3398.


STEPHEN R. CROW
PRIMARY EXAMINER
ART UNIT 332